



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,627	06/20/2005	Kiyoshi Ando	09617.0001	4183
22852 7590 08/06/2007 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				
			EXAMINER BELYAVSKIY, MICHAIL A	
			ART UNIT 1644	PAPER NUMBER
			MAIL DATE 08/06/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/510,627

Applicant(s)

ANDO ET AL.

Examiner

Michail A. Belyavskyi

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 2-5 and 11-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 6-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Art Unit: 1644

DETAILED ACTION

1. Claims 1-20 are pending.

2. Applicant's election of Group I, claims 1 and 6-10 in the reply filed on 05/31/07 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

3. Claims 2-5 and 11-20 are withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b) as being drawn to nonelected inventions.

Claims 1 and 6-10 read on a method for diagnosing leukemia, pre-leukemia or aleukemic malignant blood disease, wherein stem cells growth factor (SCGF) is quantified are under consideration in the instant application.

4. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

5. Claim 6 is objected to as being dependent on non-elected claim 5.

Appropriate correction is required.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1 and 6-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1644

8. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted step is resolution step: it is unclear how to diagnose leukemia, pre-leukemia or aleukemic malignant blood disease by quantifying SCGP in an in-vivo sample. The minimum requirements for method steps minimally include a contacting step in which the reaction of the sample with the reagents necessary for the assay is recited, a detection step in which the reaction steps are quantified or visualized, and a correlation step describing how the results of the assay allow for the determination.

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 1 and 6-10 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification disclosure does not enable one skilled in the art to practice the invention without an undue amount of experimentation.

Factors to be considered in determining whether undue experimentation is required to practice the claimed invention are summarized *In re Wands* (858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988)). The factors most relevant to this rejection are the scope of the claim, the amount of direction or guidance provided, the lack of sufficient working examples, the unpredictability in the art and the amount of experimentation required to enable one of skill in the art to practice the claimed invention.

The specification only discloses a detailed examples of construction and characterization of polyclonal and monoclonal antibody for SCGF (See entire document, Examples 1-6 in particular). The Specification also disclosed that said antibodies have been used to detect the level of in serum of healthy individuals and in patients with leukemia and pre-leukemia or other blood diseases (see overlapping pages 57-59 and Fig.7 in particular). However, it is noted that the specification disclosed that "in general the distribution of the measured values of a disease group of the interested **partially overlaps those of the non-disease group**". (see overlapping pages 12 and 13 in particular). Moreover, the specification disclosed that there were patient that were diagnosed as being disease negative in spite of being a disease patients (see page 12 in particular). The Specification further disclosed that no significant differences was observed

Art Unit: 1644

between the values of SCGF for patients of aplastic anemia and health individuals (see page 58 in particular). Moreover, based on the data presented in Fig. 7 one skill in the art would not recognized that there is any statistically significant differences between the levels of SCGF in the serum of healthy individuals and those with leukemia. In other words, the Specification provides no data that there is a correlation between the levels of serum SCGF and predictability of blood diseases. Moreover, it is noted that the is no recognition in the prior art that the levels of SCGF in serum of the patients can serve as an indicative of leukemia, pre-leukemia or aleukemic malignant blood disease. Thus, in the absence in the instant Specification and in the prior art evidences allowing one skill in the art to correlate the levels of SCGF in the serum of the patients and predisposal of said patients to leukemia, pre-leukemia or aleukemic malignant blood diseases, the intended method for diagnosing said diseases by measuring the levels of SCGF are fraught with uncertainties.

The specification does not provide sufficient teaching as to how it can be assessed that a patient has leukemia , pre-leukemia or aleukemic malignant blood disease by quantifying the levels of SCGP. Thus, although, the specification describes the means of measuring the levels of SCGF in the serum of patient, there is no correlation on this record between the levels of said growth factor and a proposed method for diagnosing leukemia, pre-leukemia or aleukemic malignant blood diseases in currently available form for humans or animals. It is not enough to rely on *in vivo* studies where, as here, a person having ordinary skill in the art has no basis for perceiving those studies as constituting recognized screening procedures with clear relevance to efficacy in humans or animals (emphasis added). Ex parte Maas, 9 USPQ2d 1746.

Thus, Applicant has not provided sufficient guidance to enable one skill in the art to use claimed method for diagnosing leukemia, pre-leukemia or aleukemic malignant blood disease by measuring the levels of SCGF in manner reasonably correlated with the scope of the claims. The scope of the claims must bear a reasonable correlation with the scope of enablement. *In re Fisher*, 166 USPQ 18(CCPA 1970) indicates that the more unpredictable an area is, the more specific enablement is necessary in order to satisfy the statute.

In view of the quantity of experimentation necessary, the unpredictability of the art, the lack of sufficient guidance in the specification, the limited working examples, and the limited amount of direction provided given the breadth of the claims, it would take undue trials and errors to practice the claimed invention.

11. No claim is allowed.

Art Unit: 1644

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michail Belyavskiy whose telephone number is 571/272-0840. The examiner can normally be reached Monday through Friday from 9:00 AM to 5:30 PM. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on 571/272-0841.

The fax number for the organization where this application or proceeding is assigned is 571/273-8300

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MICHAIL BELYAVSKIY, PH.D.
PATENT EXAMINER

08/03/07